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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,730	11/26/2003	Nicholas Frattalone	P25,565-A USA	7353

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EXAMINER
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FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,730	<b>Applicant(s)</b> FRATTALONE, NICHOLAS	
	<b>Examiner</b> Daniel S. Felten	<b>Art Unit</b> 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Receipt of applicant's reply filed July 21 2005 regarding the 37 CFR § 1.105 has been considered and is acknowledged.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2 & 4-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. What is the difference between the total rent payment and the aggregate projected periodic lease payments? Aren't rent payments and lease payments the same thing? I don't understand the distinction between the two types of payment.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 4-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over SBA Communications Corporation Announces 2<sup>nd</sup> Quarter Results; Accelerates Tower Ownership (Aug. 14,1998), SBA website (sbasite.com) and Gross et al (US 2003/0225665).

SBA discloses, *as in claims 1 & 16-25*, a method for long-term leasing by a company of a plurality of properties, two or more of which are separately owned and each of which is with an area where wireless communications facility is needed for a wireless communication network and each of which contains a location desirable for positioning said facility (see SBA, “*site acquisition*”, “*site development*”, “*leasing negotiation*”, also see paragraph 4),

identifying two or more properties to acquire thorough lease (see SBA website “site development” and Article, paragraph 4); and

SBA discloses that it offers a broad array of site acquisition, zoning construction and tower space leasing services to the wireless communication industry comprising an offer to lease each property for a term of years (see Article, paragraph 4),

SBA fails to disclose tendering to each property owner a defined lease acquisition offer, comprising an offer to lease property for a term of years with a lump sum as consideration.

However, as discussed in the previous office action dated August 12, 2004, it is conventional that a potential lump sum payment on the front, back end and credits and/or penalties are added/subtracted to the lessee's regular payment based upon the terms of the leasing agreement/offer/contract wherein the such terms are negotiated for a property over a period of years. It is also re-emphasized that since SBA provides a broad array of site acquisition, zoning, construction and leasing services that are customized to the clients needs (see Article paragraph 4); one of ordinary skill in the art would recognize the need for flexibility of SBA to provide services that accommodate the needs of the dynamic wireless community. In the area leasing agreements, the ability to be flexible and to customize site acquisition and/or leasing options/strategies would provide SBA a broader customer base and thus expand the company's growth and increase profitability.

In this case, SBA fails to disclose, the specific leasing term (or offer) wherein the total rent is less than the aggregate projected period lease payments for each property over the term of use. Gross discloses a method for leasing properties wherein the total rent for a property is less than the aggregate period lease payment over the term of use (see Gross, paragraphs 0011-0017). It would have been obvious for an artisan to recognize the advantages of the aforementioned lease term to achieve the goals of growth and profitability mentioned above, as well as to achieve advantageous accounting treatment for the parties to the transaction where the transaction is structured to enable the lessee to achieve operating lease treatment, thereby avoiding adverse impact on the lessee's balance sheet and increasing ratings. The transaction is

Art Unit: 3624

also advantageously structured to achieve leverage lease account treatment for the lessor, thereby providing favorable operating results on its reported financial statements (see Gross, *field of invention*, paragraph 0002). SBA, therefore would have recognized these advantages and used them to also provide mutually beneficial transactions between both parties as part of the lease negotiation process.

--wherein the properties are parcels on land (see SBA website and article), *as in claim 2*

--wherein at least one wireless communications facility is a part of a communications network (see SBA website and article), *as in claim 4*

--wherein said offer is to lease only a portion of each parcel of land comprising said desirable location, and any necessary access (see SBA website and article), *as in claim 5*

--wherein said offer is to lease said entire parcel of land (see SBA website and article), *as in claim 6*

--Re claims 7-15: the various forms of payment of the lump sum (*shorter term, undivided, in lieu of rent payments, cash, negotiable securities, etc.*) are well known in the art to make it convenient for transactions to take place between parties. Therefore OFFICIAL Notice is taken by the examiner of the aforementioned methods of payment being an obvious extension

Art Unit: 3624

to the prior art SBA so as to provide a convenient (as well as conventional) transference of funds being well within the ordinary skill in the art.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742.

The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DSF

October 12, 2005

Daniel S Felten  
Examiner  
Art Unit 3624



VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600